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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/599,332	09/26/2006	Stein Kuiper	GB 040075	7040

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EXAMINER	
ORTIZ CRIADO, JORGE L	
ART UNIT	**PAPER NUMBER**
2627	
MAIL DATE	**DELIVERY MODE**
02/20/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/599,332	KUIPER ET AL.	
	Examiner	Art Unit	
	JORGE L. ORTIZ CRIADO	2627	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *26 September 2006*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-23* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-23* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *13 June 2008* is/are: a)☐ accepted or b)☒ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-23 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 2, 4-18 and 21-26 of copending Application No. 10599347.

Although the conflicting claims are not identical, they are not patentably distinct from each other because, despite difference in language regarding the "at least one first electrode" as in claim copending application claims, instant application claims provides additional limitations for an obvious variant of having at least one, in the instance case two/pair of electrodes.

Instant application claims also include additional limitations. Hence, the copending application claims are generic to the species of invention covered by the respective instant application claims. As such, the copending application claims are anticipated by the instant application claims and are therefore not patentably distinct therefrom.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Specification/Drawings

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description:

a. In Fig. 1, ref # 48.

Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 7, 15 and 19-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 7 recites the limitation "the liquid-less" portion of the chamber. There is insufficient antecedence basis for this limitation into the claim. Claim 1or claim 8 does not provide for sufficient antecedence as to whether the chamber encompasses such "liquid-less" portion, since liquid according to claim 1 is contained in the chamber. It is not clear what the Applicant is trying to encompass with this language.

Claim 15 recites the limitation "the optical relevant material of the chamber". There is insufficient antecedence basis for this limitation into the claim.

Claim 15 also recites the limitation of "the index of refraction of the electrically conductive liquid equal to that of the optically relevant material". It is not clear how the index of refraction is "different", as provided in dependency of claim 1 and at the same time being "equal". It seems that such "relevant material" is part of the surroundings of the electrically conductive liquid as claimed. Hence, this makes the claim indefinite because of the contradictory language.

Applicant cooperation is respectfully requested as to clarification in this matter.

Claims 19 and 20 fall together accordingly.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Given the broadest reasonable interpretation to the claims the following art rejections are made.

Claims 1-7 and 14 are rejected under 35 U.S.C. 102(b) as being Prins et al. by WO02/099527.

As per claim 1, Prins et al. discloses a switchable optical unit capable of controlling a beam of radiation passing through an optically active portion of the unit, which unit comprises a chamber and an electrically conductive liquid (4) contained in the chamber and having an index of refraction different from that of its surroundings, the chamber being provided with an electrode configuration wherein application of a voltage (V), from a voltage control system to electrodes causes movement of the said liquid, characterized in that the electrode configuration comprises at least one first electrode (5) fixed to the inner walls of the chamber at the position of the optically active portion, second electrode means (6) fixed to the inner walls of the chamber at positions outside the optically active portion and a third electrode (7) in contact with the conductive liquid and continuously connected to a first output of a voltage source (V of 0V), a

second output of which is connected in a first mode to said at least one first electrode (V of 0V) and in a second mode to the second electrode means (V=V); (see Figs. 1a, 1b and 3a, 3b).

As per claim 2, refer to figure 3a, Prins et al. discloses dotted lines of electrode 6, form alternatively an u-shaped cross section.

As per claim 3, Prins et al. discloses wherein the interior wall of the chamber facing the liquid is coated with an insulating hydrophobic layer (2) (see page "fluoropolymer"; page 3 line 11).

As per claim 4, Prins et al. discloses wherein the chamber comprises a medium (3) which has an index of refraction different from that of the conductive liquid (Figs. 1,3; description page 2-3).

As per claims 5 and 6, Prins et al. discloses wherein the medium is a liquid, and as in claim wherein is a gas description page 2-3.

As per claim 7, It is readily understood that if gas is being used a vacuum environment is inherently provided.

As per claim 14, Prins et al. discloses where the voltage control system is arranged to supply a voltage to the at least one of first electrode individually (see Fig. 1).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 8-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Prins et al. by WO02/099527 in view of Feenstra et al. WO03069380.

Claim 8-10 provides for having refractive lens surface, on the walls of the chambers and particularly an aspherical surface.

These features are not taught by Prins et al. switchable optical unit.

However, such configuration is well known in the art and is evidenced by Feenstra et al., see Fig. 4, a switchable optical unit having refractive lens surfaces particularly aspherical.

It would have been obvious to one of an ordinary skill in the art at the time of the invention to provide such refractive lens surface in order to provide for a variable focus device.

Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Prins et al. by WO02/099527.

As per claim 15, finding the index of refraction with respect to its surroundings would have been merely routine skill in the art which would have understood that they can be freely chosen and adapted to the envisaged application.

Claims 16 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Prins et al. by WO02/099527 in view of Onuki et al. US Patent Application Publication 2002/0176148.

Although Prins et al. does not expressly disclose a controllable lens system in a camera/hand-held device having a switchable optical unit.

This is merely one of the well known applications for such optical switchable units, as evidenced by Onuki et al.

It would have been obvious to one of an ordinary skill in the art to provide such optical system units to obtain at very least light beam change capabilities.

Allowable Subject Matter

Claims 18, 21 and 22 would be allowable if the rejections on the ground of nonstatutory obviousness-type double patenting are resolved.

Claims 19 and 20 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action.

Claims 11-13 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims and if the rejections on the ground of nonstatutory obviousness-type double patenting are resolved.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JORGE L. ORTIZ CRIADO whose telephone number is (571)272-7624. The examiner can normally be reached on Mon.-Fri 10:00 am- 6:30 pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrea L. Wellington can be reached on (571) 272-4483. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jorge L Ortiz-Criado/
Primary Examiner, Art Unit 2627